

REMARKS

Reconsideration is requested.

Claims 53-55 and 58-72 are pending. Claims 58-69 have been added. Support for the amendments and new claims may be found throughout the specification. No new matter has been added. Claims 1-52, 56 and 57 have been canceled, without prejudice.

The claims are believed to read on the elected subject matter. Withdrawal of the objection to claims 29-34 and 53-55 is requested.

The Section 112, second paragraph, rejection of claims 29-41 is moot. The Section 112, second paragraph, rejection of claims 53-55 is obviated by the above amendments. Specifically, claim 55 is no longer dependent on claim 29 such that “infectious diseases” is not recited in relation to “anti-parasitic”. Moreover, new claim 58 defines the alternative of unamended claim 55. Claim 53 contains details of now-canceled claim 29 and as compared to the rejected claim 29 has been revised to insert an “or” as suggested by the Examiner on page 3 of the Office Action dated March 4, 2009. The Examiner is requested to reconsider the proposed revision of “and” to “or” in claim 29, as repeated in amended claim 53, as suggested on page 3 of the Office Action dated March 4, 2009 as the “and” is believed to be required to comply with the Examiner’s requirement that the claims read on the elected subject matter.

Claim 53 has been revised to include details of claim 29, as further revised to obviate the Section 112, second paragraph, rejection based on the Examiner’s comments in the first paragraph on page 4 of the Office Action dated March 4, 2009.

Moreover, the previous provisos of claim 29 have not been repeated in revised claim 53. Withdrawal of the Section 112, second paragraph, rejection is requested.

The Section 112, first paragraph "written description", rejection of claims 29-41 is moot. The Section 112, first paragraph "written description", rejection of 53-55 is obviated by the above amendments. Withdrawal of the rejection is requested.

The provisos of claim 53 are believed to be supported by the disclosure. Support for the recitation of claim 53 is believed to be found throughout the specification, such as, for example, in Table 1, on pages 9-10 of the specification, and specifically in compounds 7-11.

The applicants believe the negative proviso of the amended claims is supported by the originally-filed specification, based on *In re Johnson*, 194 USPQ 187 (CCPA 1977). Specifically, the issue before the court in *Johnson* involved the written description support for a negative limitation added to the claims to exclude the subject matter of a lost count in an interference. Specifically, the *Johnson* court held that a claim to a genus with a recital of a negative proviso that did not literally appear in the specification complied with the *description* requirement. The negative proviso had the effect of excluding from the scope of the claim two species originally disclosed in the specification as within the invention, and was inserted to avoid having the claims read on a lost interference count. The claim recited a formula O-E-O-E', wherein E and E' were both positively defined, and ended "with the provisos that E and E' may not both include a divalent sulfone group and may not both include a divalent carbonyl group

linking two aromatic nuclei." The proviso literally excluded more than the two species.

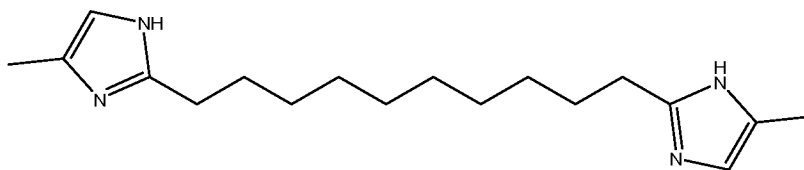
The court stated:

"The notion that one who fully discloses and teaches those skilled in the art how to make and use a genus and numerous species therewithin, has somehow failed to disclose, and teach those skilled in the art how to make and use, that genus minus two of those species, and has thus failed to satisfy the requirements of §112, first paragraph, appears to result in hypertechnical application of legalistic prose relating to that provision of the statute. All that happened here is that appellants narrowed their claims to avoid having them read on a lost interference count." See 194 USPQ 196.

In a manner similar to the appellant in *Johnson*, the applicants have excluded from the claims above those species found by the Examiner to be in the art. See the disclosure of 1:10-bis-(4-methyl-2-glyoxaliny)-decane in Lamb (JCS, 1253-1257, 1939). No new matter has been added.

The Section 102 rejection of claims 29-36 over Rai (U.S. Patent No. 3,222,285) is moot in view of the above.

The Section 102 rejection of claims 29-36, 39 and 53-55 over Lamb (JCS, 1253-1257, 1939) is obviated by the above amendments. For completeness and specifically with regard to the pharmaceutical composition claims, the applicants submit that the compound 10-bis-(4:5-dihydro-2-glyoxaliny)decane of the reference is reported to be inactive and does not include the substituent "Z" of the present claims, while the compound 1:10-bis-(4-methyl-2-glyoxaliny)-decane



does not fall within the

above claims.

Withdrawal of the Section 102 rejection based on Lamb is requested.

The Section 102 rejection of claims 29-36 and 39 over CAS Registry No. 334785-11-4 is moot in view of the above.

The Section 102 rejection of claims 29-36 and 39 over Oxley (JACS 497-506, 1947) is moot in view of the above.

The Section 103 rejection of claims 29-36 over Shreve (U.S. Patent No. 2,744,166) or Rai (U.S. Patent No. 3,222,285) is moot in view of the above.

The Section 103 rejection of claims 29 and 30 over Mueller (U.S. Patent No. 5,242,948) is moot in view of the above.

The Section 103 rejection of claims 29-36 and 39 over Lamb is moot in view of the above.

The Section 103 rejection of claims 53-55 over Lamb is obviated by the above amendments. There is no suggestion in Lamb to have made the claimed invention. The 10-bis-(4:5-dihydro-2-glyoxalanyl)decane of Lamb, which is the focus of the reference, is described as being inactive and only the single compound 1:10-bis-(4-methyl-2-glyoxalanyl)-decane of the cited "King, Lourie, and Yorke" is described as having "considerable activity". Lamb fails to teach or suggest the claimed invention. Withdrawal of the Section 103 rejection based on Lamb is requested.

VIAL et al.
Appl. No. 10/521,329
Atty. Ref.: 1721-83
Amendment
September 4, 2009

The claims are submitted to be in condition for allowance and a Notice to that effect is requested. The Examiner is requested to contact the undersigned in the event anything further is required in this regard.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: /B. J. Sadoff/
 B. J. Sadoff
 Reg. No. 36,663

BJS:
901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100